

Remarks/Arguments:

Examiner Interview:

Applicants and Applicants' representative appreciate the time and courtesy extended by the Examiner during the Examiner Interview conducted by telephone on Wednesday, December 2, 2009. The Examiner Interview was attended by Brett J. Rosen (Reg. No. 56,047) and Examiner Robert Reese. During the interview, Mr. Rosen and Examiner Reese discussed the relationship between claim 7, U.S. Patent App. Pub. No. 2003/0140888 to Tanaka and U.S. Patent No. 4,815,419 to Kitada. Applicants' representative thanks Examiner Reese for his helpful suggestion in overcoming the cited art, and has amended claim 7 consistent with the Examiner's suggestion.

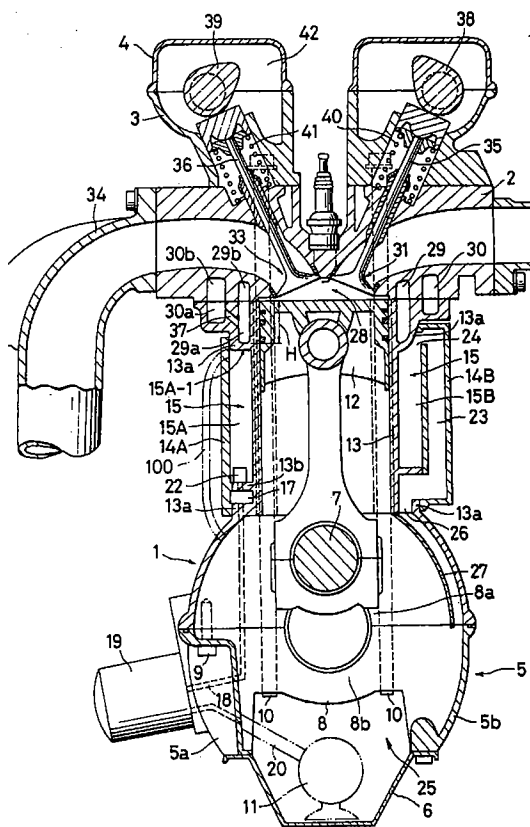
Claim Status:

Claims 7-9 and 11-16 are pending. Applicant has added claims 14-16. Claim 16 is based upon claim 7. No new matter has been added.

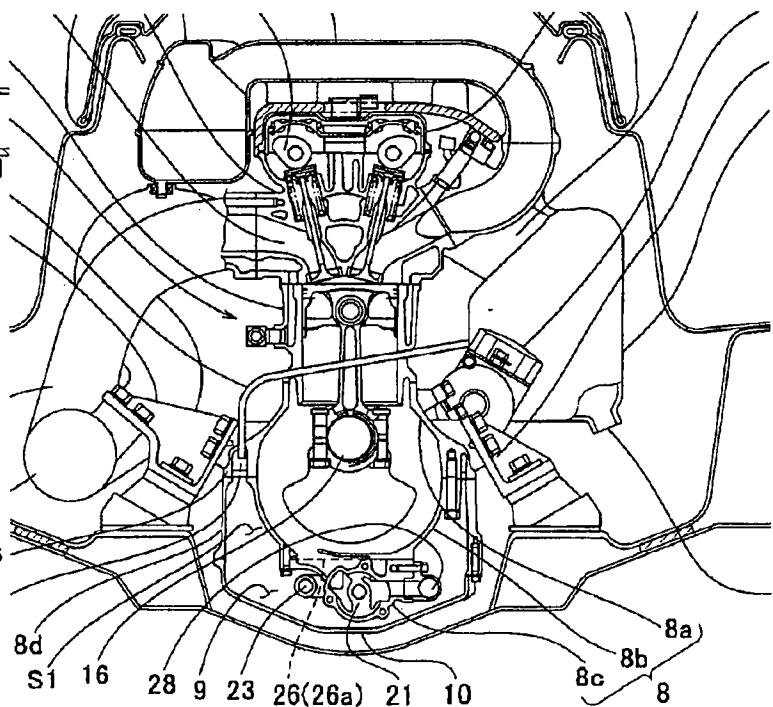
Claim Rejections under 35 U.S.C. 103:

Claims 7, 8, 11 and 12 stand rejected as obvious over U.S. Patent App. Pub. No. 2003/0140888 to Tanaka in view of U.S. Patent No. 6,823,968 to Baeumler and U.S. Patent No. 4,815,419 to Kitada. Applicants respectfully request reconsideration of these claims and respectfully submit that these claims are patentable over the cited references for the reasons set forth hereinafter.

The Office Action's combination of Kitada and Tanaka does not disclose "a wet-sump oil supply container that is fluidly coupled to the annular space for receiving defoamed lubricant oil from the annular space," as recited in claim 7. If Kitada's annular space 15 (shown to the left) were added to Tanaka's cylinder (shown to the right), as proposed by the Office Action, then Kitada's annular space 15 would be located above and fluidly coupled to Tanaka's oil space (item 8). Thus, the annular space around Tanaka's cylinders would not be fluidly coupled to Tanaka's wet-sump oil container (item 9).



KITADA



TANAKA

The Office Action's combination of Kitada and Tanaka also does not disclose "an oil return pump that is configured to convey lubricant oil out of the dry-sump oil suction space, through an oil suction line, and directly into an annular space arranged around cylinder groups," as recited in claim 7. In the telephone Interview, it was suggested that Katada's conduit 18 could be connected to Tanaka's discharge passage 28 to deliver oil from Tanaka's dry-sump oil suction space 8 to an annular space arranged around Tanaka's cylinder groups (as taught by Katada). Applicants respectfully submit that such a modification would render Tanaka's engine unsatisfactory for its intended purpose of being a dry-sump engine and would change the principle of operation of Tanaka's engine.

More specifically, as explained previously, if Kitada's annular space 15 were added to Tanaka's cylinders, as proposed by the Office Action, then the annular space around Tanaka's cylinders (as taught by Kitada) would be positioned above and fluidly coupled to Tanaka's oil space (item 8). Thus, Tanaka's pumps 21 and 22 would circulate oil from Tanaka's oil space 8 to the annular space around Tanaka's cylinders (as taught by Kitada) and back to Tanaka's oil space 8. Accordingly, the oil could not return to Tanaka's wet-sump oil space 9. Bypassing the wet-sump oil space 9 would convert the oil space 8 into a wet-sump oil space, thereby rendering Tanaka's engine unsatisfactory for its intended purpose of being a dry-sump engine and changing the principle of operation of Tanaka's engine.¹

For at least the foregoing reasons, Tanaka, Baeumler, and Kitada further do not establish *prima facie* obviousness of claims 7, 8, 11, and 12 because the references as a whole do not describe all of the elements of claim 7, and by dependence, claims 8, 11, and 12.

Claims 9 and 13, which depend from claim 7, stand rejected as obvious over Tanaka, Baeumler, and Kitada, and further in view of U.S. Patent No. 5,215,316 to Udagawa. Udagawa generally relates to metal laminate gaskets used in open-deck engines. However, Udagawa does not supply any of the elements of claim 7 missing from the combination of Tanaka, Baeumler, and Kitada as detailed above. Thus the combination of Tanaka, Baeumler, Kitada, and Udagawa does not establish *prima facie* obviousness of claims 9 or 13, either.

¹ See MPEP 2143.01: "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) ... If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)."

Conclusion:

In view of the remarks above, Applicants respectfully ask for reconsideration and allowance of the pending claims. As discussed in the Examiner Interview, Examiner Reese is invited to contact Brett Rosen at 610-993-4245 to discuss this Amendment in an effort to advance prosecution of this application.

Respectfully submitted,

A handwritten signature in cursive script that reads "Brett J. Rosen". The signature is written in dark ink and is positioned above a horizontal line.

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